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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/709,903

06/04/2004

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11/25/2009

EXAMINER

JACKSON, BRANDON LEE

ART UNIT

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3772

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/709,903	Applicant(s) HARRIS ET AL.	
	Examiner BRANDON JACKSON	Art Unit 3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 10-18, 21-31, 35-42, 46, 47, 51-55 and 58-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6-9, 19, 20, 23-34, 43-45, 48-50, 56 and 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to amendments/arguments filed 4/7/2009.
Currently, claims 1-64 and pending in the instant application.

Response to Arguments

Applicant's arguments filed 4/7/2009 have been fully considered but they are not persuasive. Applicant argues there is Klesa does not disclose a step member having a distal end that extends beyond the perimeter of the patch. However, Klesa discloses a patch (8) and a step member (20) that extends beyond the outer periphery of the patch (8), as shown in Figs 1 & 2. Fig. 4 shows the freedom of movement of the distal end of the step member (20) that extends beyond the patch (8).

Further, Applicant argues Klesa does not teach vibration dampening device. Though Klesa explicitly disclose vibration dampening, the structural elements of Klesa are the same as the claimed invention. If Klesa teaches all the positively claimed elements, then it reads on the claimed invention; even without being called a vibration dampening device, because it would be fully capable of functioning as a vibration dampening device.

Applicant argues the element 8 of the Klesa's device is a belt, not a patch. However, element 8 can be construed as a patch because a patch is merely a piece of material that covers a wound or injured body part. Applicant has not provided any special definition for patch that would not read on element 8 or Klesa. Therefore,

element 8 is a patch because it is a piece of material fully capable of covering an injured body part.

Applicant argues the Klesa does not teach a vibration dampening device, but a buckled restraining device. However, the Klesa device is not structurally different from the claimed invention. The Klesa device is not precluded from reading on Applicant's claims because it is described as being used for a different function; as long as it reads on the claims. Moreover, vibration dampening devices are known to be wrap devices, such as those used for tennis elbow or tendonitis of the knee. Therefore, the Klesa device can be used as a vibration dampening device.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 6-9, 19-20, 43-45, and 48-50 rejected under 35 U.S.C. 102(b) as being anticipated by Klesa (US Patent 2,998,008). Klesa discloses a vibration dampening device (fig. 1) for engaging human skin (col. 1, lines 7-9), comprising a patch (8) having nominal width, length, and defining an outer periphery (fig. 1); a body contacting surface (1); and a step member (20) engaged to the patch (8). The step member (20) has a distal end (fig. 1) that extends beyond the outer periphery and has freedom to move (fig. 4) with respect to the patch (8). The step member (20) has two

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ends that extend beyond the outer periphery of the patch (8). The step member (20) is slideably engaged to the patch (8) by threading it through first and second slots (12, 14). A loop (19) is in the central portion of the step member (20). The skin-contacting surface (1) at the central portion is constrained (fig. 2) from moving with respect to the skin to which the patch (8) is engaged. There is an extension (fig. 1) on the distal end of the step member (20), wherein the step member (20) has a length and a center axis along its length.

With respect to claims 43-45 and 48-50, Klesa discloses all the structural elements of claims 43-45 and 48-50; therefore the method steps would be inherent because they would have resulted from the use of the Klesa device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 32 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klesa (US Patent 2,998,008) in view of Bartlett (US Patent 6,155,999). Klesa substantially discloses the claimed invention; see rejections to claims 1 and 43 above. Klesa fails to disclose an adhesive for adhering the device to human skin. However, Bartlett teaches a tendon decompression device (10) comprising an adhesive skin-contacting layer (26) to adhere the device (10) to human skin. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the Klesa device with adhesive, as taught by Bartlett, in order to hold the device stationary after application. Moreover, the Klesa/Bartlett device teaches all the structural elements of claim 43, therefore the method steps would be obvious to one of ordinary skill in the art because they would have resulted from the use of the Klesa/Bartlett device.

Claims 33-34 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klesa (US Patent 2,998,008). Klesa substantially discloses the claimed invention; see rejections to claims 1 and 43 above. Klesa fails to disclose the step member (20) is made of a viscoelastic material having a density in the range of 7 to 15 pounds per cubic foot, a tensile strength from 40 to 80 psi, a minimum elongation of 100%, and a compression deflection at 25% of from 3 to 10 psi. However, Applicant has not stated that these parameters solve a stated problem or provide any specific advantage. The Klesa step member would function equally as well as Applicant's step member. Therefore, it would be obvious to one of ordinary skill in the art to make the Klesa step member of the viscoelastic material described by Applicant. Moreover, the Klesa device

teaches all the structural elements of claim 57, therefore the method steps would be obvious to one of ordinary skill in the art because they would have resulted from the use of the Klesa device.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **BRANDON JACKSON** whose telephone number is (571)272-3414. The examiner can normally be reached on Monday - Friday 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571)272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brandon Jackson/
Examiner, Art Unit 3772

/BLJ/

/Patricia Bianco/
Supervisory Patent Examiner, Art Unit 3772